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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,955	03/11/2004	Timothy D. Killinger	29618/39225D	7721
4743 7590 09/04/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER NEWTON, JARED W	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,955

Applicant(s)

KILLINGER ET AL.

Examiner

Jared W. Newton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final rejection is in reply to the remarks filed June 20, 2007, by which claims 1, 4, 5, 9, 12, 13 and 17 were amended, and claim 21 was cancelled. Claims 1, 2, 4-10 and 12-20 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-10 and 12-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the following recitations were not described in the specification as originally filed:

- “wherein the file support structure is configured such that a file disposed on the file suspension device is completely disposed between the first and second panels” (claim 1, lines 22-23);
- “a file folder with hooks, the hooks being disposed on the file suspension device, and the folder being completely disposed between the first and second panels” (claim 9, lines 20-21);

- “the openable panel is pivotable between the open condition and the closed condition without moving the top panel” (claim 17, lines 8-9).

The new subject matter should be canceled from the claims.

Claim Rejections - 35 USC § 102

Claims 1-8 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,505,388 to Solomon.

In regard to claims 1 and 17, Solomon discloses an expandable filing system comprising: an exterior shell 10 having an outer surface (see FIGS. 1 and 2); an openable panel 16 defining part of the exterior shell, the openable panel having a bottom edge 32, a forward facing surface, and a rear facing surface (see FIG. 2), the openable panel 16 being pivotal about the bottom edge 32 outward from the exterior shell between a retracted condition (see FIG. 2) at which the forward facing surface is generally flush with the outer surface of the exterior shell and an open condition 34 (see FIG. 2, phantom) away from the outer surface of the exterior shell; and

a file support structure (see Abstract, ln. 14-15) capable of suspending a file at any position along its length when the openable panel is in the open condition, said structure having a file storage area, an open top for insertion, access to, and removal of files from the file storage area, a pair of panels 66 extending rearward from the rear facing surface of the openable panel defining in part the file storage area, and a file suspension device (upper edges of panels 66—see col. 2, ln. 55-65) provided to suspend files completely within the file storage area, the file support structure disposed

adjacent to the rear facing surface of the openable panel and being movable in concert with the openable panel (see FIG. 2), wherein the open top is accessible when the openable panel is in the open condition (see FIG. 2, phantom) and wherein the file support structure is disposed within the exterior shell when the openable panel is in the retracted condition (see FIG. 2). Solomon further discloses said openable panel as pivotable between the open condition and the retracted condition without moving the top panel.

In regard to claim 2, Solomon further discloses the exterior shell comprising: a pair of opposed side panels 12 and 14; and a front panel 16 defined at least in part by the openable panel (see FIG. 2).

In regard to claims 3 and 18, Solomon further discloses the file support structure comprising: a pair of suspension surfaces (upper edges of panels 66) on laterally spaced apart and opposed side of the open top (see FIG. 2).

In regard to claim 4, Solomon further discloses the pair of suspension surfaces arranged to present files suspended in the file storage area in a forwardly and downward cascading arrangement (see FIG. 2, phantom).

In regard to claims 5 and 19, Solomon further discloses each pair of suspension surfaces as arched (see FIG. 2).

In regard to claims 6 and 7, Solomon further discloses the exterior shell comprising a top panel 22 providing a generally horizontal support surface in the form of a table when the openable panel is in the retracted position (see FIG. 2).

In regard to claim 8, Solomon further discloses the exterior shell and the openable panel 16 as combinable to form a configuration that hides the file storage area of the storage device when the openable panel is in the closed condition (see FIG. 2).

In regard to claim 20, said suspension surfaces extend continuously from the openable panel to a rear end (see FIG. 2).

Claim Rejections - 35 USC § 103

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,505,388 to Solomon as applied to claims 1-8 and 17-20 above, and further in view of US Patent No. 4,666,047 to Fletcher.

Solomon discloses the expandable filing system as set forth above, including all of the limitations of claims 10-16. Solomon does not specifically set forth the file suspension supports (shown as the upper edges of panels 66) as having a series of notches. Fletcher discloses a hanger support for filing cabinets comprising: frame members 26 and 28 for supporting stationary rails 18 and 20, said rails adapted for receiving suspension rails 50 and 52 for supporting file hangers (see FIGS. 1 and 6). Fletcher further discloses each of said stationary rails comprising a plurality of notches 44 (see FIG. 1), wherein said notches retain said suspension rails, and thus said file hangers. The Solomon and Fletcher references are analogous art because they are from the same field of endeavor—file suspension devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the notches as disclosed by Fletcher on the upper edges of the panels as disclosed by Solomon. The

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motivation would have been that as set forth by Fletcher—to maintain files in a spaced relationship (see Fletcher, col. 4, ln. 4-15). It would be an obvious and successful improvement to the upper shoulders of the panels 66 of Solomon, to provide said shoulders with evenly spaced notches, in order to maintain files in an evenly spaced and orderly manner.

Response to Arguments

Applicant's arguments filed June 20, 2007 have been fully considered but they are not persuasive.

With respect to Applicant's Amendments to claims 1, 9, and 17, as noted above the claims include new subject matter that was not described in the application as originally filed. With respect to the newly added limitations of claims 1 and 9 regarding a "file disposed on the file suspension device [being] completely disposed between first and second panels" (Remarks, page 10), the Applicant states, "Support for the amendments to claims 1, 4, 5, 9, 12, 13 and 17 may be found in the specification and claims as originally filed" (id). The Applicant has failed to provide reference to pages or lines of the specification and claims as originally filed, and upon a thorough examination of the specification and claims as originally filed, the Examiner is unable to discern support for the new limitations. Moreover, the drawings as originally filed do not support the newly added limitations. As seen in Figure 3, the file folders 52 comprise an extension (perhaps a hook) that extends over the suspension surface 54. Also, as

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shown in Figure 7, the ridges of the stepped mechanism 90 are located outside of the file support structure.

With respect to the newly added limitation of claim 17, it is respectfully asserted that the limitation was not set forth in the specification as originally filed. It is improper to import limitations into the claimed invention that were not expressly described, or for which no motivation was given in the original specification. It appears that the Applicant has included this limitation in an attempt to overcome the Solomon reference; however, the specification does not disclose this feature. Moreover, Applicant recites, "Solomon fails to disclose or suggest an openable panel that pivotable without moving a top panel" (Remarks, page 11). On the contrary, as set forth above, Solomon is capable of functioning in the recited manner. For instance, when the top panel of Solomon is in an "open" position (see FIG. 2), nothing prevents the openable panel from pivoting between an open and closed position. Therefore, although the noted limitation of claim 17 is deemed new subject matter, it is nevertheless anticipate by the Solomon reference.

Because the Applicant's arguments are based on new subject matter to overcome the 35 USC § 102 rejections based on Solomon, they are deemed unpersuasive.

With respect to the rejections under 35 USC § 103(a), Applicant recites, "In particular, each of claims 9-16 recites a file storage device having a file suspension device disposed adjacent to first and second panels wherein a file disposed on the file suspension device is completely disposed between first and second panels" (Remarks,

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page 11). In view of the new matter rejections above, a prior art reference or combination of references need not teach the noted limitations, and the Fletcher reference is maintained as disclosing the deficiencies of the Solomon reference as set forth above. Applicant further recites, "there is no motivation to combine the teachings of Solomon and Fletcher" because "Fletcher discloses hanging 'sheets' or 'drawings,' neither of which are files, let alone hanging files" (Remarks, pages 11-12). Both the Solomon reference and the Fletcher reference teach a device for facilitating the support of consecutive objects. Two references need not teach use with a common item in order to be properly combinable. Rather, the secondary reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The combination of the Solomon and Fletcher references meets both prongs of this analysis. First, the references are in the same field of endeavor—supporting hanging objects in a filing system (see Abstracts of both Solomon and Fletcher). Second, both references attempt to achieve the common purpose of orderly supporting and storing the objects. It is therefore maintained that the references are proper analogous art, and the rejection is upheld as set forth above. See MPEP 2141.01(a).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWN

August 24, 2007

Kambiz Abdi
Supervisor – AU 3692

